

REMARKS

Claims 1-10 are pending. By this Amendment, new claim 10 is added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Claims 1, 2 and 4-9 were rejected under 35 U.S.C. § 103(a) over Thompson, U.S. Patent No. 4,239,039, in view of Robinson, U.S. Patent No. 6,239,338. This rejection is respectfully traversed.

Robinson is directed to a non-analogous art and is therefore not combinable. In particular, Robinson is not in the same field of endeavor and does not relate to solving the same problems which Applicant solved as described in the present specification.

First, Robinson is directed to a saxophone muffler and is therefore not in the same field of endeavor as the claimed apparatus for supplying breathable gas. Second, Robinson is not directed to maximizing treatment compliance and also the comfort of the patient and/or any bed partner, by minimizing the sound made by the noise producing components of the apparatus delivering breathable gas. Instead, the purpose of Robinson is to provide a damping device for a musical instrument which is specifically adapted for a saxophone since previous dampeners for musical instruments typically only dampen the bell portion of the instrument, whereas a saxophone has specific configuration in which noise also emanates from the upper part of the saxophone. Accordingly, Robinson does not meet the criteria for analogous arts and therefore its use in the rejection is improper.

In addition, even if Robinson was from an analogous art, which it is not, one of ordinary skill in the art would not have been motivated to look toward Robinson to modify the Thompson apparatus for delivering breathable gas. This combination, if it were to be made, would be based on impermissible hindsight. One of ordinary skill in the art to which Thompson pertains (breathable gas apparatus) would not look toward the saxophone art, especially since Thompson does not recognize the need to dampen noise and Robinson does not recognize application outside the musical instruments arena.

Dependent claims 2 and 4-9 are patentable by virtue of their dependence on claim 1, in addition to the recitation of additional patentable subject matter. For example, the Office Action, in paragraph 6, acknowledges that the Thompson/Robinson combination fails to teach that the opening is sealable by adhesive tape. To make up for this deficiency, the Office Action states that the particulars of the sealing means are mechanical expedients. As requested in the previous response, in accordance with MPEP § 2144.03, the Examiner is

requested to produce one or more references teaching this feature so that Applicant may access any such teachings and whether they are combinable with Thompson/Robinson.

Further, claim 7 specifies that the enclosure includes a first aperture sealable with respect to the exterior of the inlet of the inlet muffler and a second aperture substantially sealable with respect to the exterior of the outlet of the outlet muffler. In contrast, Robinson teaches that the enclosure includes an aperture for the mouthpiece of the saxophone, but there is no mouthpiece for the bell of the saxophone – the bell is enclosed within the enclosure. Thus, Robinson does not teach that there is a second aperture substantially sealable with respect to the exterior of the outlet of the outlet muffler (the bell). Claim 8 adds even further details which are not taught or suggested by the Thompson/Robinson combination.

Further, claim 10 specifies that the flexible enclosures produced from plastic material from designed to dampen noise from the at least one noise producing component. By contrast, Robinson teaches that the enclosure includes two components, an external layer and an internal layer of soft sound-dampening material. Robinson does not teach that the external layer is a plastic material designed to dampen sound, as recited in claim 10. Applicant respectfully submits that removal of Robinson's soft sound dampening material would prevent the Robinson muffler from functioning – meaning the outer layer serves no damping function.

Withdrawal of the rejection is respectfully requested.

Claim 3 was rejected under 35 U.S.C. § 103(a) over Thompson in view of Robinson and further in view of MacGregor, U.S. Patent No. 5,996,578. However, MacGregor, like Robinson, is from a non-analogous art, *i.e.*, an underwater device. One of ordinary skill in the art simply would not have combined the CPAP apparatus, a saxophone muffler and an underwater device. Moreover, although the Office Action states that it would have been obvious to use the MacGregor plastic material to resist corrosion from water, ultraviolet light and for impermeability to gas, none of those features are desirable for the saxophone muffler of Robinson. The only basis for making this combination is impermissible hindsight, which is not the proper basis for establishing a *prima facie* case for obviousness. Withdrawal of the rejection is respectfully requested.

In view of the above amendments and remarks, Applicant respectfully submits that all the claims are patentable and that the entire application is in condition for allowance. Should the Examiner believe that anything further is desirable to place the application into better

condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: Caroline D. Dennison

Caroline D. Dennison

Reg. No.: 34494

Tel. No.: (703) 905-2047

Fax No.: (703) 905-2500

CDD:dlh
1600 Tysons Boulevard
McLean, VA 22102
(703) 905-2000